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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,694	05/03/2001	Jacques Banville	QA211	7932

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EXAMINER

KUMAR, SHAIENDRA

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 01/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,694

Applicant(s)

BANVILLE ET AL.

Examiner

SHAIENDRA - KUMAR

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4 and 9 is/are rejected.
- 7) ☐ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicants' communication filed in paper # 7, on 10/29/03.

Claims 1-10 are pending in this application.

1. Applicant's election with traverse of Group I, claims 1-9 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Examiner's assertion is unsupported by an example. This is not found persuasive because as cited in WO 0009114, the instant claimed compounds can be used as intermediate for making final product.

The requirement is still deemed proper and is therefore made FINAL. Additionally, applicants have elected species on page 51 for the examination purposes. Thus claims 5-6 are further withdrawn from the consideration being non readable on the elected species.

The examiner examined another closed species wherein, X1 is O, R1, R2, Ra, Rb, R3, R4, Y and X are hydrogen and Z is OH. In view of the fact that a reference was found that anticipates instant claims, the restriction requirement and species election is enforced properly.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/10/01 and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-4 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Kun et al(WO 0009114).

Kun et al, on page 29, line 13-14, compound anticipates instant claims, when in the instant claims, X1 is O, R1, R2, Ra, Rb, R3, R4, Y and X are hydrogen and Z is OH. Inasmuch the compound is in aqueous solution, pharmaceutical composition is anticipated, because water is one of the medium for aqueous solution.

5. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be **allowable to the extent that they read on the elected subject matter**, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The elected species is free of prior art and is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is 703-308-4519. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



SHAIENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
12/31/03